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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,527	10/11/2005	Eberhard Schmid	ADV0001-US	9242
28970 7590 09/06/2007 PILLSBURY WINTHROP SHAW PITTMAN LLP P.O. BOX 10500			EXAMINER	
			IP, SIKYIN	
MCLEAN, VA 22102			ART UNIT	PAPER NUMBER
			1742	
			MAIL DATE	DELIVERY MODE
			09/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)			
	10/520,527	SCHMID ET AL.			
Office Action Summary	Examiner	Art Unit			
	Sikyin Ip	1742			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DY - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period of the second period for reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tir will apply and will expire SIX (6) MONTHS from the cause the application to become ABANDONE.	N. nely filed the mailing date of this communication. ED (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on 26 Ju					
,—					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims					
4)⊠ Claim(s) <u>1 and 3-6</u> is/are pending in the application.					
4a) Of the above claim(s) is/are withdrawn from consideration.					
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>1 and 3-6</u> is/are rejected.					
7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/o	or alaction requirement				
are subject to restriction and/o	r election requirement.				
Application Papers					
9)☐ The specification is objected to by the Examine	er.				
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:					
1. Certified copies of the priority documents have been received.					
2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.					
Attachment(s)					
1) Notice of References Cited (PTO-892)	4) Interview Summar				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08)	Paper No(s)/Mail [5) Notice of Informal				
Paper No(s)/Mail Date <u>6/26/07</u> .					

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter such as amended lower limit of P "0.011" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no literal support in the specification as original filed

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Claim Rejections - 35 USC § 103

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
 - Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-6 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 6346215 to Boegel et al.

Claims 1 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5487867 to Singh.

Boegel discloses Cu based alloys containing Sn, Fe, Mn, Zn, and P (col. 5, lines 9-50) and the known uses of the Cu based alloys such as jewelry and clothing accessories (abstract) and eyeglass frame (col. 2, lines 1-21). Singh discloses Cu based alloys include Sn, Fe, Mn, Zn, and P (col. 3, lines 1-20). The claimed intermediate products have no structures which read on product as taught by cited references. As stated in In re Peterson, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003), that "A <u>prima facie</u> case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art". Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

The resilience property is recited in relative term not defined in measurable unit, which is possessed by all materials.

Response to Arguments

Applicant's arguments filed June 26, 2007 have been fully considered but they are not persuasive.

More particularly, Boegel does not disclose, teach, or suggest at least the feature of an alloy having a composition (in weight-percent) of "P 0.011 to 0.05 %" and "Fe 0.001 to 0.02 %,"

Applicants argue that "as recited in claim 1, for example. Rether, Boegel indicator that "in the presence of iron, high."

But, applicants' attention is directed to Boegel (col. 5, lines 21-23) that "Iron can be partially or completely replaced in this alloy composition with cobalt." So iron content in Boegel is from 0 to 5 wt.% which overlaps the claimed "0.001 to 0.02 wt.%."

Applicants argue that

Furthermore, Singh does not disclose, teach, or suggest at least the feature of a "nickel"free alloy . . . having properties of resilience," as recited in claim 1, for example. Rather, Singh-" The resilience
property is recited in relative term not defined in measurable unit, which would be
possessed by all materials.

Conclusion

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121; 37 C.F.R. Part §41.37 (c)(1)(v); MPEP §714.02; and MPEP §2411.01(B).

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SIKYIN IP PRIMARY EXAMINER ART UNIT 1742

S. Ip

September 4, 2007